REMARKS

Without prejudice or surrender of any subject matter, claims 1 and 11 have been amended to put them in better form. Claims 14-19 have been added to further point out and distinctly claim aspects of the invention. Accordingly, claims 1-19 are now pending. The specification has been amended to correct informalities. No new matter has been added by these amendments.

Claims 1-13 have been rejected under 35 USC 103 as being unpatentable over U.S. patent 6,055,564 to Phaal in view of U.S. Patent 6,341,369 to Degenaro. However, for the reasons as stated in Applicants previous response (dated 3/18/2003), which is incorporated herein by reference, and for additional reasons as indicated herein, Applicants believe that the cited references do not support these claim rejections.

To reiterate, as indicated in **35 USC 103(c)**, "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability** under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person" (emphasis added). In the present case, the Examiner cites Phaal (6,055,564) although both Phaal and the claimed invention have been subject to an obligation of assignment to Hewlett-Packard Company. Accordingly, Phaal does not preclude patentability of the claimed invention in the present application. Namely Phaal is improperly relied on as prior art in the claim rejections under 35 USC 103. For this reason, the aforementioned claim rejections should be reconsidered and withdrawn.

Then again, assuming hypothetically that it did not fall within 35 USC 103(c), Phaal would still not support the aforementioned claim rejections, singly or in combination with Degenaro. In responding to Applicants' arguments in the previous (3/18) response, the Examiner relies on *In re Gulack* and *In re Lowry* for the proposition that the only differences between the claimed invention and the cited art, Degenaro and Phaal, is in the nonfunctional descriptive material. *In re Gulack*, 703 F.2d 1381, 217

USPQ 401 (Fed. Cir. 1983) and *In re Lowry* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir 1994).

However, the **Court in *Lowry* is critical of** the Patent Office's **reliance on** *Gulack* and cautions against the liberal use of such rejections *Lowry* 32 F.3d at 1583 (citing *Gulack* 703F.2d at 1385 n.8). In particular, the Court cautions that ***Gulack*-style printed matter (i.e., nonfunctional descriptive material) rejections under 103 "stand on questionable legal and logical footing."** *Lowry* at 1583. The Court further asserts that, standing alone, the description of an element of the invention as nonfunctional (printed) matter tells nothing about the differences and that the **"printed matter cases have no factual relevance where the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer."***Id.* The Court then advises that the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO; and, **"[i]f examination... does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent."**

Applying these principles to the data structure, the Court in *Lowry* concluded that the Board erred by denying the patentable weight to the data structure limitations, i.e. to data structure with plurality of attribute data objects (ADOs) which are stored in memory and impose physical organization that facilitates data management by the processing system. Lowry at 1583 & 1584. Indeed, the Court concluded that the printed matter cases have no factual relevance in *Lowry*. *Lawry* at 1583.

Applying the foregoing principles to the claims in present application, the **method and system as defined by claims 1-13 require that external-client requests, and responses, to which classifications attach**, much like the ADOs in *Lowry*, **be processed not by the mind but by a machine, the computer.** As such, claims 1-13 are patentably distinguishable from the cited references and the rejections relying on *Gulack*'s rational are improper. In other words, **as the Examiner failed to meet the burden of establishing a *prima facie* case of unpatentability, without more the Applicants are entitled to grant of the patent."** *Lowry* at 1584.

Indeed, as recited, claim 1-13 are directed to a system and method, respectively, for providing data service. This service is provided in response to requests for transactions received from clients that are external to the data service system. Intelligent classification is one beneficial effect of the claimed embodiments of the invention as recited in claims 1-13. To that end, a rule engine is employed to analyze responses to transaction requests and a tag generator is used for generating a classification based on the analysis by the rule engine. Such classification is attached to respective responses as well as to subsequent requests for transactions that belong to the same session as their predecessor transaction requests. Moreover, transaction requests that have not yet been classified, e.g., assigned a priority via a tag (as is the case in new sessions), are serviced based on a default classification (that, unless later changed by the tag generator, attaches to their corresponding responses and any subsequent request within the same session).

Unlike the method and system as recited in claims 1-13, the *classification* in Degenaro *determines the outcome of an act of classifying* (and it does *not determine scheduling transaction requests from external clients*). See, e.g., Abstract. Degenaro focuses on specifying, choosing, and applying rules to classification-based [business] decision points in an application (col. 3, lines 4-38 and col. 4, lines 39-45). The business rules are identified in Degenaro based on *"classification"*, *i.e., assessment of application state* (as it is defined in col. 4, lines 51-53). This is clearly *contrasted with* the method and system as recited in claims 1-13 in which the *analysis, based on the business rules, determines classification, except in cases where default classification is assigned* to unclassified transaction request. In other words, Degenaro does not provide for the deficiencies of Phaal (to which the Examiner referred in the aforementioned Office Action at page 3).

Accordingly, Applicants respectfully submit that, as the cited references do not support the claim rejections and claims 1-13 are patentably distinguished from these references, the claim rejections should be reconsidered and withdrawn. Then, as a *prima facie* case has not been made, without more, Applicants are entitled to grant of a patent. *Lowry* at 1584.
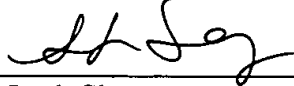
The foregoing arguments apply with equal force and effect to the new claims. Accordingly, claims 14-19 are likewise allowable over the cited references.

The application is believed to be in condition for allowance. Accordingly, a Notice of Allowance is hereby solicited.

Respectfully submitted,

Dechert LLP,

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By:_____

Leah Sherry

Reg. No. 43,918

DECHERT LLP
Customer No. 37509
P.O. Box 10356
Palo Alto, CA 94303
Tel: (650) 813-4800
Fax: (650) 813-4848